Modified PTO/SB/33 (10-05)

PRE-APPEAL BRIEF REQUEST FOR REVIEW	Docket Number Q77969	
Mail Stop AF Commissioner for Patents P.O. Box 1450 Alexandria, VA 22313-1450	Application Number 10/695,817	Filed October 30, 2003
	First Named Inventor Shinobu TANAKA	
	Art Unit 2836	Examiner Carlos David Amaya

WASHINGTON DC SUGHRUE/265550

65565

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Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal

The review is requested for the reasons(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

☑ I am an attorney or agent of record.

Registration number 39,283

Signature

J. Warren Lytle, Jr.

Typed or printed name

(202) 293-7060

Telephone number

January 5, 2007

Date

PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of

Shinobu TANAKA

Docket No: Q77969

Appln. No.: 10/695,817

Group Art Unit: 2836

Confirmation No.: 7177

Examiner: Carlos David Amaya

Filed: October 30, 2003

For: UNQUALIFIED PERSON DRIVING PREVENTION APPARATUS FOR VEHICLE

PRE-APPEAL BRIEF REQUEST FOR REVIEW

MAIL STOP AF - PATENTS
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Pursuant to the Pre-Appeal Brief Conference Program, and further to the Examiner's Final Office Action dated September 5, 2006, Applicant files this Pre-Appeal Brief Request for Review. This Request is also accompanied by the filing of a Notice of Appeal.

Applicant turns now to the rejections at issue:

Claims 1-13 and 15 are all the claims pending in the application, of which claims 1, 8 and 13 are independent.

Claims 1-6 are rejected under 35 U.S.C. § 102(e) as being anticipated by Berthiaume (US 6,772,061). Berthiaume does not anticipate independent claim 1 since it does not disclose the claim limitation of "a marker detector provided in the vehicle to detect the qualified person marker held by a driver having a driving qualification appropriate for driving the vehicle only

when the driver holds the qualified person marker opposite the marker detector." (emphasis added)

The Examiner asserts in the Advisory Action that Berthiaume teaches this claim limitation "since the driver has to hold the key 110 in order to place it in data port 120, and a qualified person (qualified person being the person holding the key) is detected only when the key is held opposite data port 120." See Figs. 5, 6A-C, 7A-B and 9A-C, for example.

Applicant respectfully disagrees with the Examiner's assertion since claim 1 requires the marker detector to detect a qualified person marker "only when the driver holds the qualified person marker opposite the marker detector." In the Berthiaume reference it is clear that key 110 (the alleged marker) is not detected "only when the driver holds the qualified person marker opposite the marker detector." Rather, the driver places the key on data port 120 and the data port holds the key in place, as shown for example in figures 5, 6A-6C, 7A and 7B, 9A-9C and 10A and 10B. Berthiaume explains this at col. 7, lines 24-26 ("Once mounted upon data port 120a, a key 110a may be retained in position by friction between an inner surface of key cap 16 and port housing 126.") The driver need not hold the key over the data port 120 for the key to be detected. This is because the key is detected constantly while the vehicle is operating, including after a driver releases the key after mounting the key onto the data port 120. See, for example, col. 6, line 66 through col. 7, line 10 ("...proximity signal S20 may indicate to apparatus 102 that key 110a has become detached from or is otherwise separated from data port 120a.") When the

key 110a is separated the vehicle can be shut down. See col. 7, lines 7-8. Accordingly, Berthiaume does not teach this limitation of claim 1 and therefore does not anticipate claim 1.

Independent claims 8 and 13 are rejected under 35 U.S.C. § 103(a) as being obvious over Berthiaume in view of Roed. Claim 8 very specifically recites "a marker detector provided in a floor of a cab of the vehicle to detect a qualified marker provided in a shoe worn by a driver having a driver qualification appropriate for driving the vehicle." The Examiner admits that Berthiaume does not disclose either a marker detector in the floor of a cab or a qualified marker provided in the shoe of a driver. The Examiner cites Roed for teaching a marker placed in a shoe and asserts that Roed and Berthiaume are analogous art and therefore it is proper to combine the teachings. However, these two references are quite difference and are not analogous art which a person of ordinary skill in the art would have consulted in dealing with the problem of restricting drivers of vehicles.

The Examiner implies that the two references are analogous because they supposedly meet a two-part test. First, whether the reference is within the field of the inventor's endeavor. If not, then second, it must be determined whether the reference is reasonably pertinent to the particular problem with which the inventor was involved. See Advisory Action. Applicant respectfully submits that Roed is not directed to operating a vehicle at all, but rather is directed to detecting a person's location who is walking on a machine shop floor. Nor is Roed directed to the particular problem the inventor faced. It is quite clear from the application that the problem the inventor solves is preventing an unqualified person from driving a vehicle, not monitoring a

person's location on a machine shop floor as in Roed. See, for example, page 2 lines 13-16. Accordingly, even under the two-part test the Examiner advances, it is clear that the Roed and Berthiaume references are not analogous art.

Even if Berthiaume and Roed are deemed to be analogous art, it would not have been obvious to combine the teachings so that a driver of the Berthiaume vehicle would wear the key 110 in the driver's shoe. Berthiaume is directed to recreational vehicles such as a personal watercraft (e.g., a jet ski) and all terrain vehicles (ATVs). See col. 2, lines 63-65. To suggest that a person of ordinary skill in the art would have been motivated to place Berthiaume's key 110 in the vehicle operator's shoe based on Roed's use of a sensor in a shoe used on a machine shop floor, ignores the references as a whole and just does not make sense.

Berthiaume relates to recreational vehicles and expressly calls out a personal watercraft as one such vehicle. It is respectfully submitted that it is well known that personal watercraft operators often drive such vehicles barefoot, without wearing any shoes. Accordingly, a person of ordinary skill in the art would not look to a reference that places a marker in a person's shoe to modify a reference that is concerned with personal watercraft that often are driven barefoot. Accordingly, it would not have been obvious to modify Berthiaume based on Roed as the Examiner asserts.

Even considering a land vehicle such as the ATV mentioned in Berthiaume, it still would not have been obvious to have modified Berthiaume to place a marker in an ATV driver's shoe. It is respectfully submitted that it is well known that ATVs commonly are driven in off-road

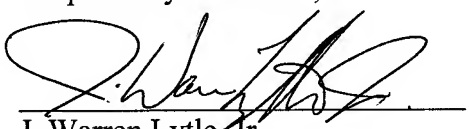
areas where the terrain is rugged. Driving over such rugged terrain would likely cause a driver's shoe to constantly bounce off the floor of the ATV. As such, it is respectfully submitted that placing the marker in the ATV driver's shoe would cause the ATV to repeatedly turn off as the driver's shoe separates from the ATV floor due to driving the ATV over the rugged terrain. Hence, it would not have been obvious to modify Berthiaume based on Roed as asserted by the Examiner.

Independent claim 13 also requires that "the qualified marker is disposed in a shoe of a driver qualified to drive the vehicle." Accordingly, it is respectfully submitted that it would not have been obvious to combine the teachings of Berthiaume and Roed as the Examiner asserts. Hence, the prior art does not render claim 13 unpatentable.

The remaining claims depend from one of the independent claims discussed above, and hence, are not rendered unpatentable for at least the same reasons.

Accordingly, Applicant respectfully requests withdraw of the rejections.

Respectfully submitted,



J. Warren Lytle, Jr.
Registration No. 39,283

SUGHRUE MION, PLLC
Telephone: (202) 293-7060
Facsimile: (202) 293-7860

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